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APPLICATION NO. 137	FILING DATE 10/24/97	FIRST NAMED INVENTOR REED	ATTORNEY DOCKET NO. E 514425-3566
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IM71/0901

EXAMINER

AHMED, S

ART UNIT

PAPER NUMBER

1773

DATE MAILED: 09/01/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks



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08/957,187 10/24/97 BEER

E 514425-3566

EXAMINER

IM62/0712

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ART UNIT

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07/12/99

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Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/957,187

Applicant(s)
Beer et al.

Examiner
Sheeba Ahmed

Group Art Unit
1773



☒ Responsive to communication(s) filed on May 10, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 9-19 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 9-19 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Response to Amendments and Arguments

1. Amendments in the above-identified application have been entered. Claims 1-8 have been canceled. New claims 9-19 have been introduced.

Applicant's arguments with respect to claims 1-8 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

2. Claim 9 is objected to because of the following informalities:

Claim 9, lines 2: "A least one layer...." should be "At least one layer.....".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 9-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 9 recites the limitation “at least one cycloolefin polymer selected from the group consisting of the class of polymers comprising from 0.1 to 100% by weight, based on the total weight of the cycloolefin polymer, of polymerized units of at least one cyclic olefin of the formulae I, II, II', III, IV, V or VI”. There is no antecedent basis for the phrase “the class of polymers” in line 8 of claim 9. Furthermore, the language of claim 9 is ambiguous. Alternative expressions are permitted if they present no uncertainty or ambiguity with respect to the question of scope or clarity of the claims. A proper alternative expression would recite selection from “a class of polymers consisting of polymerized units of at least one cyclic olefin of the formulae I, II, III, IV, V, or VI. See MPEP § 2173.05(h) and *Ex Parte Markush*, 1925 C.D. 126 (Comm'r Pat. 1925).

Claims 17-19 provide for the use of the mono- or multilayer film of claim 9, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Dependent claims incorporate all the limitations of the independent claim. The language of claims 9 and 17-19 should be amended to clarify what is meant to be encompassed by the claims.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 17-19 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 9-14 and 17-19 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Hirose et al. (US 5,532,030).

Hirose et al. disclose a multilayer laminate in which sheets or film based on polyolefins are laminated to form a material for packing. The multilayer laminate comprises a layer made from at least one cycloolefin-based resin selected from the group consisting of (a1) an ethylene/cycloolefin

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random copolymer obtained by polymerizing a cycloolefin (represented by the formula (1) or (2)) with ethylene, (a2) a ring-opening polymer of the cycloolefins or its hydrogenation product and (a3) a graft-modification product of (a1) or (a2) (Column 1, lines 13-16, 54-64 and Column 2, lines 1-5). The structure of the cycloolefin component is given in Column 2 wherein n may be zero or 1, m may be zero or any positive integer, q may be zero or 1 and the substituents R_1 - R_{18} may be a radical selected from the group consisting of hydrogen atom, halogen atom and hydrocarbon groups and wherein the R groups may form a monocyclic or polycyclic ring by combining with each other. The halogen atoms may be fluorine, chlorine, bromine or iodine and the hydrocarbon groups may be C_1 - C_{20} alkyl groups, C_1 - C_{20} halogenated alkyl groups, C_3 - C_{15} cycloalkyl groups and C_6 - C_{20} aromatic hydrocarbons (Column 4, lines 8-25). The ethylene/cycloolefin random copolymer usually contains the constituent unit derived from ethylene in an amount of 52-90 mole % and the constituent unit derived from a cycloolefin in an amount of 10-48 mole%. The ethylene/cycloolefin copolymer may contain constituent units derived from other copolymerizable monomers such as monocyclic olefins in an amount of 20 mole % or less (Column 21, lines 64-67, Column 22, lines 1-4, 66-67, Column 23, lines 31 and Column 24, lines 1-2). The cycloolefin-based resin may be blended with other resins and various additives (Column 29, lines 56-67). The multilayer laminate may be subjected to monoaxial or biaxial stretching to produce a sheet or film material suitable for packaging drugs, foods and cigarettes. Such a material has superior moisture-proof properties and therefore may be used as a blister pack, bottle or other type of container (Column 34, lines 33-67 and Column 35, lines 1-19). The thickness of

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the laminate is 100 microns as indicated in Table 1 in Columns 35 and 36. With regards to the limitations of the water vapor permeation and puncture resistance, the Examiner takes the position that these properties are inherent in the multilayer laminate disclosed by Hirose et al. given that the composition and structure of the laminate disclosed by Hirose et al. and the laminate of the claimed invention are identical. All limitations of the claimed invention are either inherent or disclosed in the above reference.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hirose et al. (US 5,532,030).

Hirose et al., as discussed above, disclose the claimed invention but do not specifically state that the multilayer film may be stretched at a ratio of 1.1 to 4.0. However, the Examiner takes the position that it would have been obvious to one having ordinary skill in the art to stretch the multilayer film of Hirose et al. to any chosen ratio given the reasonable expectation of equivalent results and absent a showing of criticality.

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7. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hirose et al. (US 5,532,030) in view of Tanaka et al. (U.S. 5,556,920).

Hirose et al., as discussed above, disclose the claimed invention but do not specifically state that the multilayer film may contain inorganic fillers. However, Tanaka et al. disclose a monoaxially stretched polypropylene film composition comprising a crystalline polypropylene and a monocyclic olefin polymer (Refer to the Abstract). Anti-blocking agents may be added to the stretched films (Column 6, lines). Examples of inorganic anti-blocking agents that may be used include silica, alumina, and calcium carbonate (Column 6, lines 66-67). Accordingly, it would have been obvious to one of ordinary skill in the art to fabricate polymeric films that contain fillers particularly since Tanaka et al. suggest that addition of anti-blocking agents leads to films of improved transparency, image clarity and formability (Column 8, lines 40-43 and 51-56).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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8. Claims 9-14 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of copending Application No.

08/994,863. Although the conflicting claims are not identical, they are not patentably distinct from each other. The only difference between the claims is that 08/994,863 further claims that the mono- (single-) or multilayer film is heat-sealable at a temperature which is 5 to 70°C higher than the glass transition temperature and that the sealing time is 0.1 to 10 seconds. The Examiner takes the position that it would be obvious to one having ordinary skill in the art to fabricate a mono- or multilayer film using the constituents claimed in 08/994,863 or to produce a heat sealable multilayer film using the constituents claimed in the instant invention such that the film is heat-sealable at a temperature 5 to 70°C higher than the glass transition temperature and wherein the sealing time is 0.1 to 10 seconds given that all other limitations (including the structure and composition of the constituents) are the same.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheeba Ahmed whose telephone number is (703) 305-0594. The Examiner can normally be reached on Monday-Friday from 8am to 5pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Paul Thibodeau, can be reached at (703) 308-2367. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-5436.



Sheeba Ahmed
July 7, 1999



Paul Thibodeau
Supervisory Patent Examiner
Technology Center 1700